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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,261

06/16/2006

Anders Stokki

78200-062

4585

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7590

10/07/2009

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EXAMINER

NGUYEN, KHANH TUAN

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/596,261

Applicant(s)

STOKKI ET AL.

Examiner

KHANH T. NGUYEN

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 15-19, 21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 15-19, 21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date n/a.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Final

Response to Amendment

1. This Office action is in response to the amendment filed on 07/29/2009. Claims 12, 15-19, 21 and 23-26 are currently pending without additional amendment made. Claims 1-11, 13-14, 20 and 22 have been canceled.

Claim Status

2. The rejection of Claims 12, 15-18 and 23-26 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 5,516,546 (Hari) in view of U.S. Pat. 200310113566 A1 (Clemens) and further in view of U.S. Pat. 5,626,948 (Ferber) is maintained for the reasons of record. The rejection of Claim 19 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 5,516,546 (Hari) in view of U.S. Pat. 200310113566 A1 (Clemens) and U.S. Pat. 5,626,948 (Ferber) and further in view of either U.S. Pat. 5,120,811 (Glotfelter) or U.S. Pub. 200510227104 A1 (Kim) is maintained for the reasons of record. The rejection of Claims 21 and 26 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 5,516,546 (Hari) in view of U.S. Pat. 2003/0113566 A1 (Clemens) and U.S. Pat. 5,626,948 (Ferber) further in view of U.S. Pat. 4,101,689 (Wienand) is maintained for the reasons of record.

Information Disclosure Statement

3. No additional information disclosure statement (IDS) submitted.

Response to Arguments

4. Applicant's arguments filed on 07/29/2009 have been fully considered but they are not persuasive.

5. ***The rejection of Claims 12, 15-18 and 23-26 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 5,516,546 (Hari) in view of U.S. Pat. 200310113566 A1 (Clemens) and further in view of U.S. Pat. 5,626,948 (Ferber) is maintained for the reasons set forth on pages 3-6 of the Office action mailed on 05/04/2009.***

6. In response to the Applicant's remark on page 5, last paragraph, Applicant argues that Hari does not disclose or suggest a transparent top coating. The Examiner respectfully disagrees with the Applicant argument. Applicant should refer to Figure 3 of Hari wherein Hari discloses a conductive topcoat 5. Hari further suggest that the conductive coating comprises of a binder such as polyurethane (Col. 2, line 9-11 and Col. 4, lines 22-23). Polyurethane resin is known to be a transparent resin. For example, US Pat. 5,786,785 to Grindrup et al recognized polyurethane coating to be transparent (Col. 4, lines 28-31).

Applicant also argues that Hari does not disclose or suggest incorporating substantially spherical glass particles in a top coating. And that Hari does not disclose or suggest coating such particles with a conductive coating comprised of silver, aluminum, copper, nickel, gold, or an alloy thereof with another metal. The Examiner respectfully disagrees with the Applicant argument. Applicant refutes prior art

reference(s) individually, rather than in combination. In response to applicant's piecemeal analysis of the Hari references, "one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references." In *re* Keller, Terry, and Davies, 208 USPQ 871, 882 (CCPA 1981). In the instant case, Hari reference is not relied upon to suggest the incorporation of substantially spherical glass particle in a top coating nor is Hari relied upon to suggest coating such particle with a conductive coating comprising of silver, aluminum, copper, nickel, gold or an alloy thereof with other metal, thus one can not argued that Hari does not disclose or suggest incorporating substantially spherical glass particles in a top coating nor can it be argued that Hari does not disclose coating said glass particle with a conductive coating comprising of silver, aluminum, copper, nickel, gold or an alloy thereof with other metal. As its known, "non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. Thus, [prior art reference] must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole." In *re* Merck & Co., Inc., 231 USPQ 375, 380 (CA FC 1986).

Applicant further argues that Hari employs amorphous or spheroidal graphite and/or carbon fibers and/or finely divided metal. None of these materials are employed as particles in applicants' pending claims. While Hari may suggests material that is not employed by the pending claims, nonetheless the additional material of Hari is permissible since the pending claims contain the "comprising" transitional phase which leaves the claims open for the inclusion of unspecified ingredients even in major

amounts, see *Ex parte Davis et al.*, 80 USPQ 448 (PTO Ed. App. 1948). Also, the “comprising” terminology do not exclude the presence of other ingredients in the composition, unlike the narrow “consisting of” language, see *Swain v. Crittendon*, 332 F 2d 820, 14 1 USPQ 8 11 (CCPA 1964).

7. At page 6 of the remark, Applicant argues that Clemens topcoat is not transparent. The Examiner respectfully disagrees with the Applicant argument. Applicant should refer to paragraphs [0077] and [0115] of Clemens wherein Clemens suggest the topcoat composition comprising of electrically conductive material such as carbon black or silver coated glass spheres and thermoplastic resin such as polyurethane. As stated above, polyurethane resin is known in the art to be capable of forming transparent coating with silver coated glass spheres as evident by US Pat. 5,786,785 to Grindrup et al. (See Col. 4, lines 28-31 of Grindrup et al).

Applicant further argues that Clemens teaches away from Applicant's claimed invention because a colored and decorative topcoat has a decorative purpose whereas a transparent topcoat as claimed allows decorative to show through. The Examiner respectfully disagrees with the Applicant argument. The Examiner would like to point out that nowhere in the instant claim disclose the purpose of the transparent topcoat of the instant invention to allow decorative to show through. Applicant's argument that Clemens teach away from examiner's interpretation, examiner asserts disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. In re Susi, 169 USPQ 423, 426 (CCPA 1971). Furthermore, knowledge in the art may have advanced such that results

considered incredible at one time are no longer per se incredible. Ex parte Rubin, 5 USPQ2d 1461, 1462 (BdPatApp&Int 1987). In the instant case, Clemens teaches a coating system having the same utility as claimed, i.e. floor coating (see [0071], [0076], and [0090]). At paragraph [0031], Clemens teaches the topcoat (and basecoat) composition may or may not contain the optional ingredients such as pigments. Thus, the pigment-free polyurethane topcoat of Clemens is considered to be a colorless transparent topcoat for floor covering. Clemens further teaches adding silver coated glass bead into the coating composition to render it electrically conductive [0077]. The two different intended uses are not distinguishable in terms of the composition. Therefore, Clemens is considered to teach the claimed invention.

8. At connecting pages 5-6 of the remark, Applicant appears to argue that because the top composition layer of Ferber comprises of pigment, therefore it is not transparent and can not support the rejection. The Examiner respectfully disagrees with the Applicant argument. First, the Examiner would like to point out that Ferber suggest a top composition layer comprising of polyurethane resin (Col. 4, lines 13-15 and Col. 7 line 64) and silver coated glass spheres (Col. 9, lines 41-42) as claimed. Next, Applicant should refer to column 9 line 66 to column 10 line 2 of Ferber wherein Ferber states:

"The top composition layer preferably comprises pigment in an amount of between about 1%-60%. It should be understood that pigment is not required in all embodiments of the present invention." (Emphasis Added)

Ferber discloses the top composition layer need not comprise a pigment, thus the top composition layer of Ferber may be pigment free and transparent as claimed.

Furthermore, the Examiner takes the position that when the top composition layer of Ferber comprises low amount of pigment, i.e. about 1%, it does not affect the transparency of the top composition layer as to not allowing the bottom layer to show through. In other words, the top composition layer of Ferber may contain small amount of pigment in order to provide color to the top composition layer while maintaining transparency in transparent top composition layer. Lastly, the Examiner notes that the USPTO is not equipped to perform laboratory testings and experimental benchworks to measure the properties of the resulting composition. The burden is on the applicant to prove otherwise.

9. At connecting pages 7-8 of the remark, Applicant argue that Kojimoto reference employed conductive material in an amount greater than 10% and does not overlap with Applicant's claimed range of 0.1-10 wt. %, thus Kojimoto can not support the rejection of Claim 15. It is noted that Applicant had presented the same argument in the previous remark filed on 09/19/2008 at page 6 (1st paragraph). In response to this argument, the Examiner has withdrawn the rejection over Kojimoto at point 2 of the previous Office action mailed on 05/04/2009. The Examiner would like to point out that Claim 15 was intended to be rejected over Hari in view of Clemens and further in view of Ferber as written in the 103 rejection heading at page 3, point 4, of the previous Office action mailed on 05/04/2009.

4. Claims 12, 15-18 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 5,516,546 (Hari) in view of U.S. Pat. 2003/0113566 A1 (Clemens) and further in view of U.S. Pat. 5,626,948 (Ferber).

Clearly, the above prior art to Hari, Clemens and Ferber in combination teaches the claimed silver coated glass particle within the claimed proportion of 0.1 to 10 wt. % in a transparent polyurethane resin, thus the silver coated glass particle of the prior art is expect to have a dry bulk resistivity as recited in Claim 15, i.e. between 0.0001 and 0,01 Ohms/cm. "Products of identical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (fed. Cir. 1990). See MPEP 2112.01 II. Note that structurally similar compounds (i.e. silver coated glass particle) are generally expected to have similar properties (i.e. dry bulk resistivity). *In re Gvurik*, 596 F. 2d 1012,201 USPQ 552. It should have been obvious to Applicant that the rejection of Claim 15, recited at page 5 of the previous Office action mailed on 05/04/2009, rejected over Kojimoto should have been rejected over Hari, Clemens and Ferber instead of Kojimoto.

10. The rejection of Claim 19 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 5,516,546 (Hari) in view of U.S. Pat. 200310113566 A1 (Clemens) and U.S. Pat. 5,626,948 (Ferber) and further in view of either U.S. Pat. 5,120,811 (Glottelter) or U.S. Pub. 200510227104 A1 (Kim) is maintained for the reasons set forth on pages 6-7 of the Office action mailed on 05/04/2009.

11. At page 8 of the remark, Applicant argue that the rejection of Claim 19 should be withdrawn because the disclosures of coating thickness provided by Glottelter or Kim

are not sufficient to overcome the deficiencies of Hari, Clemens and Ferber. The Examiner respectfully disagrees with the Applicant argument. For the reasons set forth above neither Hari, Clemens nor Ferber references contain any deficiency, thus neither Glotfelter nor Kim needs to remedy any deficiency.

12. *The rejection of Claims 21 and 26 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 5,516,546 (Hari) in view of U.S. Pat. 2003/0113566 A1 (Clemens) and U.S. Pat. 5,626,948 (Ferber) further in view of U.S. Pat. 4,101,689 (Wienand) is maintained for the reasons set forth on pages 7-8 of the Office action mailed on 05/04/2009.*

13. At page 9 of the remark, Applicant argues that Wienand coated surface is not a top coating. The Examiner respectfully disagrees with the Applicant argument. At page 9 lines 7-8, Applicant acknowledged that Wienand discloses "coating both sides of a substrate. Furthermore, at column 3 lines Wienand discloses the paste composition can be applied to both sheet surfaces. Clearly, Wienand suggest not only coating the underside but also the topside of the surface, i.e. top coating. While Wienand may suggest additional steps, such as cutting the substrate into two parts, nonetheless Wienand is considered to suggest a paste that is capable of being applied to a surface top to form a top coating.

Based on the above rational, it is believed that the claimed limitations are met by the reference submitted and therefore, the rejection is maintained.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHANH T. NGUYEN whose telephone number is (571) 272-8082. The examiner can normally be reached on Monday-Friday 7:00-4:00 EST PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Kopec/
Primary Examiner, Art Unit 1796

/KTN/
Examiner
10/01/2009